



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,350	05/19/2004	Hideki Nagino	FUJY 21.183	6685

26304 7590 06/16/2006

KATTEN MUCHIN ROSENMAN LLP  
575 MADISON AVENUE  
NEW YORK, NY 10022-2585

EXAMINER
----------

SAVLA, ARPAN P

ART UNIT	PAPER NUMBER
----------	--------------

2185

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/849,350	Applicant(s) NAGINO ET AL.	
	Examiner Arpan P. Savla	Art Unit 2185	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 May 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/19/04</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The instant application having Application No. 10/849,350 has a total of 6 claims pending in the application, there is 1 independent claim and 5 dependent claims, all of which are ready for examination by the Examiner.

### **INFORMATION CONCERNING OATH/DECLARATION**

#### **Oath/Declaration**

1. Applicant's oath/declaration has been reviewed by the Examiner and is found to conform to the requirements prescribed in 37 CFR 1.63.

### **STATUS OF CLAIM FOR PRIORITY IN THE APPLICATION**

2. As required by MPEP § 201.14(c), acknowledgment is made of Applicant's claim for priority based on an application filed in the Japanese Patent Office on December 19, 2003.

### **INFORMATION CONCERNING DRAWINGS**

#### **Drawings**

The drawings are objected to under 37 CFR 1.83(a) because they fail to show the "nonvolatile memory" and "security function" within Fig. 1 as described in the specification on pg. 9, lines 6-7. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required

Art Unit: 2185

in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

## **OBJECTIONS**

### **Specification**

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
4. On page 10, the second full paragraph, line 5 the phrase "memory card 202" should read "memory card 201."
5. On page 18, the first full paragraph, lines 1 and 5 the phrases "Fig. 5" should read "Fig. 4."

6. On page 18, the last line of the page the phrase "Fig. 2" should read "Fig. 1."

**REJECTIONS NOT BASED ON PRIOR ART**

**Claim Rejections - 35 USC § 112**

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claims 2-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

9. The limitation "A storage device according to claim..." in line 1 of all the claims respectively renders the claims vague and indefinite. It is uncertain whether the storage device refers to the same "storage device" from the depending claim or an entirely new "storage device" which is similar to the "storage device" from the depending claim. For the purposes of examining the instant application the Examiner will interpret the limitation as referring to the **same** "storage device" from the depending claim." If this is true, Applicant may consider amending the claims to read "The storage device according to claim..."

10. **Also per claims 3 and 6**, the claims recite the limitation "the storage apparatus" in line 2 respectively. There is insufficient antecedent basis for this limitation in the claims. For the purposes of examining the instant application the Examiner will interpret the limitation to read "the storage device" (based on claims 1 and 4). If this is true, Applicant may consider amending the claims to read "the storage device."

11. **Also per claim 5**, the claim limitation "according to any one of claims 1" in line 1 is vague and indefinite. Applicant may consider amending the claim to read "according to claim 1."

## **REJECTIONS BASED ON PRIOR ART**

### **Claim Rejections - 35 USC § 102**

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. **Claims 1-4 and 6** are rejected under U.S.C. 102(b) as being anticipated by Tanaka (U.S. Patent 6,199,120).

14. **As per claim 1**, Tanaka discloses a storage device that is detachably attachable to an information processing apparatus, comprising:

an IC chip (col. 14, lines 10-11; Fig. 4, element 1D);

a first control unit extracting a control command for the IC chip included in a control command for the storage device from the information processing apparatus (col. 21, lines 29-36; col. 22, lines 9-18; Fig. 4, elements 2D and 3D; Fig. 13, element 5). *It should be noted that the "IC card RW apparatus" is analogous to the "first control unit" and the "host" is analogous to the "information processing apparatus." It should also be noted that the "communication protocol conversion" performed when the IC card is*

*inserted in so as to "generate an IC card command" is analogous to "extracting a control command for the IC chip included in a control command."*

and a second control unit performing interface conversion corresponding to the IC chip on the control command for the IC chip extracted by the first control unit and giving the converted control command to the IC chip (col. 14, lines 13-20; Fig. 4, element 13D). *It should be noted that the "interface section" is analogous to the "second control unit." It should also be noted that since the IC card RW apparatus performs all read/writes to the IC card (col. 22, lines 16-18) and the interface section is the only interface the IC card, it follows that it is inherently required the interface section receives the converted IC card command from the IC card RW apparatus and gives the converted IC card command to the IC card.*

15. **As per claim 2**, Tanaka discloses the second control unit performs interface conversion on data sent from the IC chip and stores the converted data in a predetermined storage area (col. 14, lines 25-29; Fig. 4, element 22D); *It should be noted the "card maker identification" is analogous to "data" and the "card maker identification information transfer section" is analogous to the "predetermined storage area."*

and the first control unit reads the data stored in the storage area in accordance with a control command for the storage device from the information processing apparatus and gives the read data to the information processing apparatus (col. 14, lines 30-34 and 58-62).

16. **As per claims 3 and 6**, Tanaka discloses first control unit receives a writing command for the storage device, in whose data area a control command for the IC chip is mapped, and extracts the control command for the IC chip mapped in the data area (col. 21, line 66 – col. 22, line 18). *It should be noted that any IC card command the RW apparatus converts is inherently required to contain a control command mapped for the IC card. If there was no control command mapped for the IC card within the RW command then the RW would not be able to access any data within the IC card.*

17. **As per claim 4**, Tanaka discloses the first control unit refers to an address area of the writing command for the storage device and, when an address is set therein which shows that the control command for the IC chip is mapped in the data area, extracts the control command for the IC chip from the data area (col. 21, line 66 – col. 22, line 18). *It should be noted that the “entry names” within the “entry table” are analogous to “addresses.” It should also be noted that it is inherently required the IC card command contain an area for the specific card maker identification (i.e. entry name) for which the command is targeted.*

**Claim Rejections - 35 USC § 103**

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



**19. Claim 5 is rejected under 35 U.S.C. 103(a) as being obvious over Tanaka in view of Nagamasa et al. (U.S. Patent Application Publication 2004/0177215).**

20. Tanaka discloses all the limitations of claim 1 except the IC chip comprises a nonvolatile memory and has a security function.

Nagamasa discloses the IC chip comprises a nonvolatile memory and has a security function (paragraph 0067, lines 29-32; paragraph 0042, lines 6-12 and 37-41; Fig. 22, element 150).

Tanaka and Nagamasa are analogous art because they are from the same field of endeavor, that being IC cards.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to implement Nagamasa's IC chip with nonvolatile memory and security processing function within Tanaka's IC card reading/writing apparatus.

The motivation for doing so would have been to provide a storage apparatus in which security is improved (Nagamasa, paragraph 008).

Therefore, it would have been obvious to combine Tanaka and Nagamasa for the benefit of obtaining the invention as specified in claim 5.

### **Conclusion**

### **STATUS OF CLAIMS IN THE APPLICATION**

The following is a summary of the treatment and status of all claims in the application as recommended by MPEP 707.70(i):

### **CLAIMS REJECTED IN THE APPLICATION**

Per the instant office action, **claims 1-6** have received a first action on the merits and are subject of a first action non-final.

**RELEVANT ART CITED BY THE EXAMINER**

The following prior art made of record and not relied upon is cited to establish the level of skill in Applicant's art and those arts considered reasonably pertinent to Applicant's disclosure. See MPEP 707.05(e).

1. U.S. Patent 5,590,306 (Watanabe et al.) discloses an IC memory card control system including an IC memory card and an IC memory card control apparatus to which an IC memory card is detachably mounted to store therein management information as well as data, the management area of the IC memory card is provided with an identification area into which are written an occupation code indicative of recording of the data in the data area and a recording code indicative of an abnormal recording of the data in the data area.
2. U.S. Patent 7,017,825 (Ohya et al.) discloses an IC card used as an electronic purse or an ID card, and a data processing method therefor, and relates in particular to a technique for processing data stored in a nonvolatile memory mounted in an IC card.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arpan P. Savla whose telephone number is (571) 272-1077. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Sparks can be reached on (571) 272-4201. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Arpan Savla  
Assistant Examiner  
Art Unit 2185  
June 12, 2006



DONALD SPARKS  
SUPERVISORY PATENT EXAMINER